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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,527	12/14/1998	DAVID E. COX	5577-108	9792

20792 7590 09/10/2004

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 09/10/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/211,527

Applicant(s)

COX ET AL.

Examiner

Bunjob Jaroenchonwanit

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,7-13,16,21-27,30 and 45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2,7-13,16,21-27,30 and 45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. In view of the Board of Appeal (BOA) Decision on 5/10/04 and newly evident found, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below. In response to the Broad decision and newly found evident.

2. In light of BOA claims' construction, applicant specification and argument presented during prosecution, Examiner analyzed and interpreted as follow. Instead of repeating the BOA and applicant argument *in toto*, Examiner interpretation of claims is directed to the substance of the claims, *inter alia*. The claims breadth required a policy or rule, which is stored in a server and the server using the policy and session dependent information for transforming content of data, e.g., information, application from one language or format or protocol to a format or language or protocol that suitable for presenting in a client device (see figure 2). Regarding, the claimed session dependent information or data was not defined anywhere in the specification. Thus, the broadest and reasonable interpretation of such phrase is, therefore, relied upon the given, examples, in the specification (page 6 line 30 to page 7, line 7), which was referred to *inter alia*, type of devices, type of network connections or transmission or type of applications. Regarding, the claimed policy, application vaguely referred to as information, preference or rule stored at a server for modifying data or application. The server then retrieves the so-called "policy" to, in conjunction with the session dependent information, modify the data application (spec. page 9, lines 12-22).

3. Since, the specification did not, in anywhere, define what exactly policy or rule or preference was. Thus, it is fair to interpret the claimed languages, *in toto*, as a method, apparatus and program stored in computer readable for modifying information, e.g., translating,

Art Unit: 2143

transforming, conversion, alteration, an application or data, to suitable for presenting and delivering to a respective client devices. The modifying based on the variation of characteristics, e.g., devices' type, network connection types, application types or users types, along with some kind of rule or client preference.

4. Examiner noted the specification often referred the session dependent information, as recited in the claims' language, for instance as appeared in claim 2. However, breadth of the claims was broadened by the apparent of the phrase "at least one", which provided an alternative limitation from all limitation to one limitation. Thus, only one imitation in the group would satisfy the requirement of the claims' limitation.

5. In light of the aforementioned specification analysis and claims' interpretation, above, the rejection of pending claims 2, 7-13, 16, 21-27, 30, 35-45, (final amended version, paper number 5, filed 7/12/01) is cited as stated below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 35 recites the limitation "program product according to claim 29" in line 1. There is insufficient antecedent basis for this limitation in the claim, i.e., depending on cancelled claim.

In context of the claim, claim 35 will be examined as depends on claim 37.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 2, 7-13, 16, 21-27, 30, 35-45 are rejected under 35 U.S.C. 102(e) as being Vishwanath et al (US. 6,216,157).

11. Regarding claims 2, 9-11, 16, 23-25, 30, 37-39, Vishwanath discloses an inventive concept for a method, apparatus and computer program stored in a readable medium, (hereinafter collectively referred to as a system), for using with a heterogeneous clients. The system is capable of transforming data, content, application or the like in accordance with type or characteristic of client devices, network connections, protocols, transmission rates, transmission mediums, types of content or application, user preferences and etc. (see abstract, fig. 4, 6-9; Col.1, 1, lines 10-44; Col. 2, lines 8-40 and specification *in toto*).

12. Regarding claims 7-8, 21-22 and 35-36, Vishwanath discloses the users are capable of entering their preferences via a client terminal, to a server, the server then in accordance with each of the preferences, i.e., policy, push a respective applications to the client devices for presenting to the users, i.e., on demand server (Col. 4, lines 11-46, specifically at lines 40-44).

Art Unit: 2143

13. Regarding claims 12, 26 and 40, Vishwanath discloses the users can enter their preference to control content, e.g., specifying LA score to be send to the user page art the end of each quarter, i.e., policy control a characteristic of content (Col. 4, lines 38-46).

14. Regarding claims 13, 27 and 41, Vishwanath discloses the content is controllable by, at least, type of network connection, which in light of specification (page 16, line 14-25), referred to selecting compression scheme in accordance with characteristic of transmission medium or transmission rate. Vishwanath clearly discloses such that in figures 6 and 7 and corresponding details in Col. 6, lines 15-Col. 7, line 17.

15. Regarding claim 43-45, breath of the claims required only one of the following limitations, removing color, removing graphic, prioritizing communication or varying preference for and application. Vishwanath clearly met the requirement, since its inventive concept allows the users to set their preferences for choosing desirable applications. Such teaching clearly inferred that the system capable of handling variation applications preferences.

16. Applicant is advised that incorporation of dependent claims 20 or 43 in Markush Group fashion, with independent claim 9 could overcome the prior art of record. The advice also is applicable to the corresponding system and computer program claims.

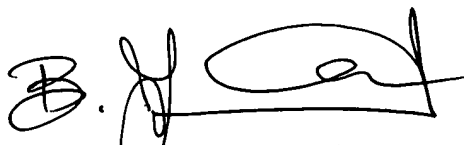
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Examiner further cited, Craddock et al. (US. 6,351,771) an analogous art which having the same objective, that is to provide data content suitable to present at remote client devices in accordance with devices or network conditions, in which examiner opined that is applicable for rejecting the pending claims.

Art Unit: 2143

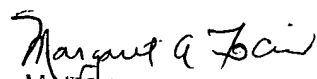
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Bunjob Jaroenchonwanit
Primary Examiner
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/bj
9/10/04


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